

**Remarks/Arguments:**

Claims 1-42 are pending in the application. Objections and rejections will be addressed in the order presented in the Office Action.

1. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. Specifically, the Examiner does not find support for all of the amounts recited in claims 11-14 and 38-40, and for the temperature ranges found in claims 19 and 21. The Applicant understands that the Examiner meant to recite claims 11-13 rather than 11-14, and responds herein accordingly. Notification by the Examiner is respectfully requested if this understanding is in error. The specification is amended herewith to incorporate the limitations of originally filed claims 11-13, 38-40, and 19. Claim 21 is amended to recite the temperature limitations found on page 11 at line 20 in the application as filed. No new matter has been added, and the Applicant submits that the objections have now been overcome.

**Rejections under 35 U.S.C. § 102**

3. Claims 1, 4, 27, 31, and 41 are rejected under 35 U.S.C. § 102(b) as anticipated by Cassens, Jr. The subject claims are amended herewith to recite formulations and methods where the compositions consist essentially of, rather than comprise, the indicated ingredients. No new matter has been added. Cassens teaches, in the examples and the claims, compositions that also includes at least a refractory aggregate containing MgO, which the compositions of the subject claims cannot contain. Thus Cassens does not teach or fairly suggest the claimed compositions or methods, and a *prima facie* case of anticipation has therefore not been presented. The rejections have therefore been overcome, and should be withdrawn.

4. Claims 1, 4, 6, 11, 27, 31, 33, 38, and 41 are rejected under 35 U.S.C. § 102(b) as anticipated by Japanese Patent Specification No. JP02-197836 (hereinafter referred to as "the '836 patent"). Claims 6 and 33 are canceled herewith. Claims 1, 4, 27, 31, and 41 are amended herewith to recite formulations and methods where the compositions consist essentially of, rather than comprise, the indicated ingredients. No new matter has been added. The '836 patent teaches, in the English abstract, compositions that also include at least ammonium thiosulfate, sodium sulfite, and EDTA, which the compositions of the subject claims cannot contain. Thus the '836 patent does not teach or fairly suggest the claimed compositions or methods, and a *prima facie* case of anticipation has therefore not been presented. The rejections have therefore been overcome, and should be withdrawn.

The Applicant traverses the rejection of claims 11 and 38, and points out that the '836 patent does not in fact teach or suggest the limitations of these claims with respect to the amounts of the recited ingredients. Claims 11 and 38 both recite that the amount of aluminum sulfate must be between about 40 wt.% and about 80 wt.%, but the example given in the English abstract of the '836 patent recites 10g of aluminum sulfate, 150g of ammonium thiosulfate, and other materials. Thus the aluminum sulfate content of the composition is less than about 6 wt% ( $=10/(160)$ ), and at least this limitation of claims 11 and 38 is not taught or fairly suggested. Thus, a *prima facie* case of anticipation has not been presented, and the rejections should be withdrawn.

5. Claims 1 and 4 are rejected under 35 U.S.C. § 102(b) as anticipated by Japanese Patent Specification No. 05-127323. Claims 1 and 4 are amended herewith to recite compositions consisting essentially of, rather than comprising, the indicated ingredients. Japanese Patent Specification No. 05-127323 teaches, in the English abstract, compositions that also include at least ammonium thiosulfate, sodium sulfite, and sodium acetate dihydrate, which the compositions of the subject claims cannot contain. Thus Japanese Patent Specification No. 05-127323 does not teach or fairly suggest the claimed compositions, and a *prima facie* case of anticipation has therefore not been presented. The rejections have therefore been overcome, and should be withdrawn.

6. Claims 1, 4, 27, 31, and 41 are rejected under 35 U.S.C. § 102(b) as anticipated by Japanese Patent Specification No. 06-194791. The subject claims are amended herewith to recite compositions consisting essentially of, rather than comprising, the indicated ingredients. No new matter has been added. Japanese Patent Specification No. 06-194791 teaches, in the English abstract, compositions that also include at least ammonium thiosulfate, sodium sulfite, and 1-phenyl-3-pyrazolidine, which the compositions of the subject claims cannot contain. Thus Japanese Patent Specification No. 06-194791 does not teach or fairly suggest the claimed compositions or methods, and a *prima facie* case of anticipation has therefore not been presented. The rejections have therefore been overcome, and should be withdrawn.

7. Claims 1 and 4 are rejected under 35 U.S.C. § 102(b) as anticipated by Chinese Patent Specification No. 1153593. Claims 1 and 4 are amended herewith to recite compositions consisting essentially of, rather than comprising, the indicated ingredients. Chinese Patent Specification No. 1153593 teaches, in the English abstract, compositions that also include at least cane sugar and chlorhexidine acetate, which the compositions of the subject claims cannot contain. Thus Chinese Patent Specification No. 1153593 does not teach or fairly suggest the claimed compositions, and a *prima facie* case of anticipation has therefore not been presented. The rejections have therefore been overcome, and should be withdrawn.

8. Claims 1, 2, 4, 27, 29, 31, and 41 are rejected under 35 U.S.C. § 102(b) as anticipated by Diesso. The subject claims are amended herewith to recite compositions consisting essentially of, rather than comprising, the indicated ingredients. No new matter has been added. Diesso teaches compositions that also include a major amount of gypsum, which the compositions of the subject claims cannot contain. Thus Diesso does not teach or fairly suggest the claimed compositions or methods, and a *prima facie* case of anticipation has therefore not been presented. The rejections have therefore been overcome, and should be withdrawn.

#### Rejections under 35 U.S.C. § 103

10. Claims 1, 2, and 4 are rejected under 35 U.S.C. § 103(a) as unpatentable over Japanese Patent Specification No. 04-170368. The subject claims are amended herewith to recite compositions consisting essentially of, rather than comprising, the indicated ingredients. Japanese Patent Specification No. 04-170368 teaches compositions for use in making refractory materials, an art area that is not analogous to that of the present invention. To serve this totally different purpose, the compositions include "as a main component" a high-alumina raw material as well as alumina cement, silica powder, and a refractory clay (see English abstract). These are essential ingredients, and the reference therefore cannot suggest any composition not containing them. Further, compositions containing these amounts and types of additional

ingredients would not be suitable for use according to the present invention. Thus, the reference neither teaches nor suggests a composition consisting essentially of the ingredients recited in the subject claims. Thus, a *prima facie* case of obviousness has not been presented, and the rejections should be withdrawn.

11. Claims 1, 4, 27, 31, and 41-42 are rejected under 35 U.S.C. § 103(a) as unpatentable over Martin. The subject claims are amended herewith to recite compositions consisting essentially of, rather than comprising, the indicated ingredients. No new matter has been added. Martin teaches compositions for use in zinc alloy electroplating, an art area that is not analogous to that of the present invention. To serve this totally different purpose, the compositions must include zinc as well as cobalt and/or nickel, and an organic brightening additive. These are essential ingredients, and the reference therefore cannot suggest any composition not containing them. Further, compositions containing significant amounts of these additional ingredients would not be suitable for use according to the present invention. Thus, the reference neither teaches nor suggests a composition consisting essentially of the ingredients recited in the subject claims. Thus, a *prima facie* case of obviousness has not been presented, and the rejections should be withdrawn.

#### Rejections under 35 U.S.C. § 112

13. Claims 1-12, 14-39, and 41-42 are rejected under 35 U.S.C. § 112, second paragraph, as indefinite. The Office Action asserts that, in the independent claims, it is unclear what types of polycarboxylic acids are encompassed. The Applicant thanks the Examiner for pointing out this potential ambiguity. Amendments have now been made to the claims as needed to indicate that the polycarboxylic acid is other than polyacrylic acid. Further, dependent claims reciting the inclusion of an additional polycarboxylic acid have been amended to clarify that such acid is different from the one recited in the corresponding independent claim. No new matter has been added. The rejections have now been overcome, and should be withdrawn.

#### Allowable Subject Matter

14. Claims 13 and 40 have been indicated to be allowable upon correction of the lack of antecedent basis noted in item 1 above. The Applicant submits that such correction has been made as outlined above, and respectfully requests allowance of claims 13 and 40.

15. Claims 3, 5, 7-10, 12, 14-26, 28, 30, and 32-40 have been indicated to be allowable if rewritten to overcome the rejections under 35 U.S.C. § 112, 2<sup>nd</sup> paragraph, to include all of the limitations of the base claim and any intervening claims, and to correct lack of antecedent basis. The Applicant submits that such corrections have been made as outlined above, and respectfully requests allowance of claims 3, 5, 7-10, 12, 14-26, 28, 30, and 32-40.

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Amendment Dated November 30, 2004  
Reply to Office Action of August 31, 2004

BCI-169US

Conclusion

For all of the reasons provided above, the Applicant urges that claims 1-5 and 7-42 are now in condition for allowance, and requests early notification to that effect. The Applicant further invites the Examiner to contact the Applicant's undersigned representative, Frank Tise, if it is believed that such contact may expedite prosecution of the application.

Respectfully submitted,

  
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Christopher R. Lewis                      Reg. No. 36,201  
Frank P. Tise                                Reg. No. 50,379  
Attorney and Agent for Applicant

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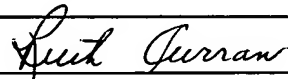
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☐ P.O. Box 980  
Valley Forge, PA 19482  
(610) 407-0700

☒ P.O. Box 1596  
Wilmington, DE 19899  
(302) 778-2500

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